

### REMARKS

Applicant respectfully requests entry of the remarks submitted herein. Claims 1-7 and 9-31 are currently pending. Reconsideration of the pending application is respectfully requested.

#### The 35 U.S.C. §103 Rejections

Claims 1-4, 6, 9, 11-23 and 26-31 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Sarneel (US 2002/0037351) and further in view of Takashima (US 2001/0055638). According to the Examiner, Sarneel discloses using starch n-alkenyl succinate and eggs in bakery products, and Takashima discloses using whey protein in bakery products. The Examiner asserted that, even though the cited references do not teach the exact range of percentages that are claimed, that the “instantly claimed ranges and that taught by the references are so close to each other” and cited *In re Woodruff*. This rejection is respectfully traversed.

According to the Examiner, *In re Woodruff* indicated that “a *prima facie* case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough so that one skilled in the art would have expected them to have the same properties” (page 4 of the current Office Action). The Examiner asserted that, although Sarneel discloses a lower amount of starch n-octenyl succinate, adjusting the amount in a composition while keeping good mouth feel “would have been within the realm of the skilled artisan” (page 4 of the current Office Action).

“[W]ithin the realm of the skilled artisan” is not the proper standard for obviousness. The Supreme Court recently addressed the standard for obviousness. According to the Supreme Court, “[r]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR International v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007), quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Also according to the Supreme Court, “[f]or an invention to be obvious under §103, ...the differences between the claimed subject matter and the prior art must reveal an explicit rationale for why one having ordinary skill in the art would have ... modified the elements in the manner claimed.” *KSR* at 1734. In addition, the Federal Circuit has been very clear that the “mere fact that the prior art could be so

modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.” *In re Gordon* 733 F.2d 900, 902 (Fed. Cir. 1984).

The present claims are directed toward a combination of starch n-octenyl succinate and whey protein, which can be used in bakery products as an egg substitute. The pending claims all require the use of starch n-octenyl succinate, whereas Sarneel discloses using any 6-carbon to 18-carbon starch n-alkenyl succinate. In addition, pending claim 1 requires 40-80% starch n-octenyl succinate, which is entirely outside of the 5 – 30% of starch n-alkenyl succinate disclosed by Sarneel. Contrary to the Examiner's assertion, 40-80% and 5-30% are not “so close to each other” such that *In re Woodruff* would apply. Further, Takashima discloses a number of recipes for microwavable sponge cake, only one of which includes whey protein (see Example 6). Notably, Takashima does not use or suggest using any type of starch succinate.

Neither of the cited references disclose using the particularly claimed amounts of starch n-octenyl succinate and whey protein as an egg substitute in a bakery product, and neither of the cited references contains disclosure that would prompt one of ordinary skill in the art to combine the claimed amounts of starch n-octenyl succinate and whey protein for use in a bakery product. In addition, the particular recipe recited in independent claim 11, which includes specific amounts of both n-octenyl succinate and whey protein, also is not disclosed or suggested by the cited references, alone or in combination. In view of the remarks herein, Applicants respectfully request that the rejection of claims 1-4, 6, 9, 11-23 and 26-31 under 35 U.S.C. §103(a) be withdrawn.

Claim 5 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Takashima, Sarneel and further in view of Gisaw et al. (US Patent No. 6,558,730); and claims 7, 10 and 24-25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Takashima, Sarneel, and further in view of Ekanayake et al. (US Patent No. 6,056,984). According to the Examiner, Gisaw et al. discloses that the starch n-octenyl succinate is derived from high amylopectin source, and Ekanayake et al. discloses a general range of ingredients for flour-based doughs and batter. These rejections are respectfully traversed.

As discussed above, independent claims 1 and 11 are not obvious over the combination of Sarneel and Takashima. Therefore, the dependent claims rejected here also are not obvious,

even in combination with Gisaw et al. or Ekanayake et al. If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and MPEP §2143.03.

In view of the remarks herein, Applicants respectfully request that the rejection of claims 5, 7, 10 and 24-25 under 35 U.S.C. §103(a) be withdrawn.

#### Obviousness-Type Double-Patenting Rejection

Claims 1-4, 9, 11, 15-17 and 26 are rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1, 4, 8 and 17 of Sarneel (US Patent No. 6,663,909) in view of Takashima (US 2001/0055638).

The present claims are not obvious over Sarneel in view of Takashima for at least the reasons set forth above. In view of the remarks herein, Applicants respectfully request that the obviousness-type double-patenting rejection be withdrawn.

#### CONCLUSION

Applicants respectfully request allowance of claims 1-7 and 9-31. Please apply any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

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/M. Angela Parsons/

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